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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/733,828
Filing Date: December 11, 2003
Appellant(s): POKEMPNER ET AL.

MAILED

DEC 18 2006
Group 3700

John G. Posa
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 09 August 2006 appealing from the Office action mailed 07 March 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: F. The rejection of claim 72 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,388,689 to Kroop et al. in view of U.S. Patent No. 5,667,064 to Bauman.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

Art Unit: 3711

(8) Evidence Relied Upon

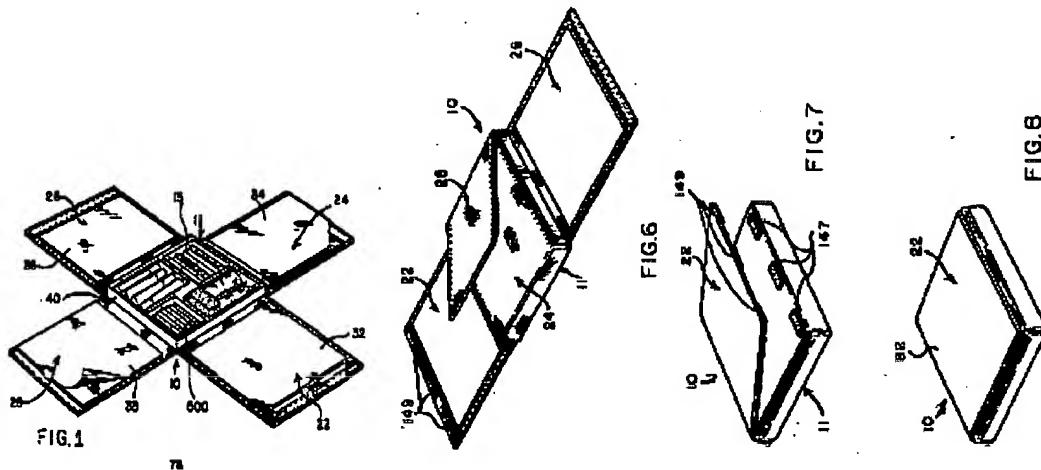
5,388,689	KROOP ET AL.	02-1995
6,164,976	WILSON	12-2000
5,671,951	PALMITER ET AL.	09-1997

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The grounds of rejection as stated in the Final Rejection (dated 07 March 2006), and are incorporated herein in their entirety by reference.

Claims 57-60, 62-64, and 67-71 are rejected under 35 U.S.C. 102(b) as being anticipated by Kroop et al.



Kroop et al. disclose an activity kit comprising a box for holding a set of writing implements (500) or other materials and a pad of paper having a back panel hinged to the box in a manner allowing the pad and box to fold against one another in overlying registration; the box and pad are generally of the same dimensions; the writing

implements (500) are differently colored markers, crayons, or pencils (col. 2, lines 39-40); the writing implements are of color-changing type (col. 2, lines 39-40); the pad of paper or book includes games (the game may be played by doodling on the pad of paper or book such as the game of HANGMAN); a fastener for holding the pad and box together (col. 7, lines 60-68 through col. 8, lines 1-3 and col. 8, lines 22-32) when folded against one another; the fastener is a hook-and-loop tab (col. 7, lines 60-68); the tab is situated on the side of the cover (see Figure 7).

Claims 1-4, 6-8, 11-22, 25-29, and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kroop et al. in view of Wilson (US Patent No. 6,164,976).

Kroop et al. disclose an activity kit comprising a box (the box 40 having side, front, and back panels, the four portions proximate reference part 40) for holding a set of writing implements (500) or other materials and a pad of paper having a separate back panel (98) hinged to the box in a manner allowing the pad and box to fold against one another in overlying registration (see Figures 6 and 8, for example); the box and pad are of generally of the same peripheral dimensions (see Figure 2, for example), the writing implements (500) are differently colored markers, crayons, or pencils (col. 2, lines 39-40); the writing implements are of color-changing type (col. 2, lines 39-20); the pad of paper or book includes games (the game may be played by doodling on the pad of paper or book such as the game of HANGMAN); a fastener for holding the pad and box together (col. 7, lines 60-68 through col. 8, lines 1-3 and col. 8, lines 22-32) when folded against one another, the fastener is a hook-and-loop tab (col. 7, lines 60-68); the tab is situated on the side of the cover (see Figure 7).

Koop et al. does not teach the activity kit having stickers.

Wilson teaches an activity kit using stickers (col. 6, line 65).

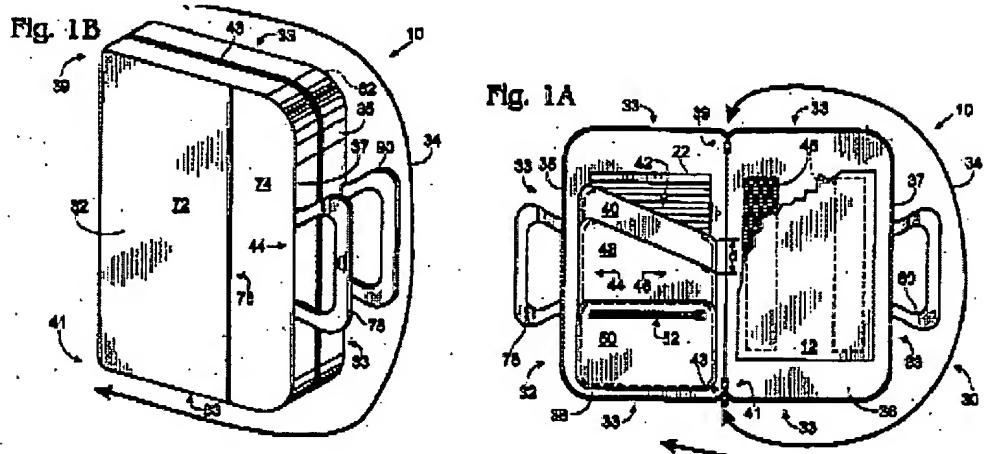
It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the activity kit with stickers as taught by Wilson, since such a modification would add greater versatility to the activity kit.

Koop et al. disclose the claimed invention except for the specific arrangement and/or content of indicia (printed matter) set forth in the claim(s). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the pad of paper with preprinted indicia since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. In re Gulack 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of writing surface does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter e.g. preprinted indicia and the substrate e.g. pad of paper which is required for patentability.

Claims 9, 10, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1 and 16 above, and further in view of Palmiter et al.

Art Unit: 3711

Kroop et al.; as modified by Wilson, lacks handles on both the box and back panel of the pad, each handle having a through-hole which is aligned with the other when folded against one another in overlying registration.



Palmiter et al. disclose a portable receptacle having a pair of handles (78,80) with a through-hole therein (the inner portion of reference numbers 78,80).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide handles with through-holes as taught by Palmeter et al., since such a modification would allow the portable receptacle to be carried or transported easily.

Claims 30-33, and 35-47, 49-56, 65, and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kroop et al. in view of Palmiter et al.

Kroop et al. disclose an activity kit comprising a box for holding a set of writing implements (500) or other materials and a pad of paper having a back panel hinged to the box in a manner allowing the pad and box to fold against one another in overlying registration; the box and pad are of generally of the same peripheral dimensions (see Figure 2, for example), the writing implements (500) are differently colored markers,

Art Unit: 3711

crayons, or pencils (col. 2, lines 39-40); the writing implements are of color-changing type (col. 2, lines 39-20); the pad of paper or book includes games (the game may be played by doodling on the pad of paper or book such as the game of HANGMAN); a fastener for holding the pad and box together (col. 7, lines 60-68 through col. 8, lines 1-3 and col. 8, lines 22-32) when folded against one another, the fastener is a hook-and-loop tab (col. 7, lines 60-68); the tab is situated on the side of the cover (see Figure 7).

Kroop et al. do not disclose handles on both the box and back panel of the pad; each handle having a through-hole which is aligned with the other when folded against one another in overlying registration.

Palmiter et al. teach a portable receptacle having a pair of handles (78,80) with a through-hole therein (the inner portion of reference numbers 78,80).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide handles with through-holes as taught by Palmiter et al., since such a modification would allow the portable receptacle to be carried or transported easily.

Claims 34 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 30 above, and further in view of Wilson (US Patent No. 6,164,976).

Kroop et al., as modified by Palmiter et al., lack the other materials including rubber stamps, ink pads, playing cards or flash cards, stickers or temporary tattoos.

Wilson teaches an activity kit using stickers (col. 6, line 65).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the activity kit with stickers as taught by Wilson, since such a modification would add greater versatility to the activity kit.

Claim 72 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kroop et al. in view of Bauman.

Kroop et al. disclose the claimed invention except for the box having a closeable flap.

Bauman teaches an activity kit in the form of a box having a closeable flap (44,45).

It would have been obvious to provide the box with a closeable flap as taught by Bauman, since such a modification would positively secure the box of the activity kit.

(10) Response to Argument

With respect to Applicant's argument that Kroop et al. (US Patent No. 5,388,689) does not disclose a box having front, back and side panels defining two front and two back edges, the Examiner submits that Kroop et al. indeed discloses a box (the box 40 having side, front, and back panels, the four portions proximate reference part 40).

In response to applicant's argument that there is no suggestion to combine the references using Wilson, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.

Art Unit: 3711

1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the examiner notes that the independent claims recite “writing implements or other materials” Kroop et al show the writing implements as claimed; therefore, Kroop et al reads on the claims since the claims are recited in alternative format. The examiner is applying the Wilson reference to reinforce the examiner’s position if the examiner erred in how the examiner construed the claims. In conclusion, the examiner maintains that Kroop et al reads on the claims as recited. If there is any doubt to this interpretation, Wilson reads on the “other materials” as claimed and the combination of the references read on the claimed subject matter. The actual contents that are placed within the kit are merely a matter of design choice dependent upon the user’s preferences. Furthermore, the kit of Kroop et al is fully capable of holding any type of material including stickers as taught by Wilson and it would have been obvious to provide Kroop et al with sticker means as taught by Wilson to provide for more versatility to the kit along with providing for a particular user’s preferences.

In response to applicant’s argument regarding the combination of references using Palmiter et al, Kroop et al disclose that the kit is portable as well as moveable (col. 8, lines 57-59). This provides sufficient motivation to combine Palmiter et al., since handles are notoriously known to be used to easily move items. Therefore, it would have been obvious to one of ordinary skill in the art to provide Kroop et al with handle means as taught by Palmiter to easily move the kit.

In response to applicant’s argument regarding the handle means of Palmiter can not be incorporated into Kroop et al, the examiner notes that the test for obviousness is

Art Unit: 3711

not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, one of ordinary skill in the art knows to use handles to make items easily transportable.

Therefore, it would have been obvious to one of ordinary skill in the art to provide Kroop et al with handle means as taught by Palmiter to easily move the kit.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Conferees:

Urszula M. Cegielnik



Eugene L. Kim



Mitra Aryanpour

